Daniel T. Pascucci, Esq. (SBN 166780)
dpascucci@mintz.com
Nathan R. Hamler, Esq. (SBN 227765)
nhamler@mintz.com
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
Telephone: (858) 314-1500
Facsimile: (858) 314-1501

Marvin S. Gittes, Esq. (*pro hac vice in case no. 3:07-cv-00893-IEG(NLS)*)
E-mail: mgittes@mintz.com
Timur E. Slonim, Esq. (*pro hac vice in case no. 3:07-cv-00893-IEG(NLS)*)
tslonim@mintz.com
Peter F. Snell, Esq. (*pro hac vice in case no. 3:07-cv-00893-IEG(NLS)*)
E-mail: psnell@mintz.com
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
666 Third Avenue
New York, NY 10017
Telephone: (212) 935-3000
Facsimile: (212) 983-3115

Attorneys for Defendant/Counter-Claimant
AMERICAN TECHNICAL CERAMICS CORP.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

PRESIDIO COMPONENTS, INC., Plaintiff, v. AMERICAN TECHNICAL CERAMICS CORP., Defendant.	Case No. 3:08-cv-00335-IEG-NLS **ATC'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS** **ORAL ARGUMENT REQUESTED**
AMERICAN TECHNICAL CERAMICS CORP., Counter-Claimant, v. PRESIDIO COMPONENTS, INC., Counter-Defendant.	Hearing Date: July 25, 2008 Hearing Time: 10:00 am Courtroom 1

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Pursuant to Federal Rule of Civil Procedure 56, Defendant American Technical Ceramics Corp. ("ATC") respectfully moves this Court for summary judgment holding that all of asserted claims 1-5, 16, 18 and 19 (the "asserted claims") of U.S. Patent No. 6,816,356 ("the '356 patent") are indefinite under 35 U.S.C. § 112, second paragraph and hence invalid.[1]

I. PRELIMINARY STATEMENT

A patent gives an inventor a right to exclude others from using anything within the scope of the patent claims.[2] Since the claims of a patent, as opposed to the specification, set the metes and bounds of the invention, the patent law requires patentees to include claims "particularly pointing out and distinctly claiming the subject matter" of the invention. 35 U.S.C. § 112, ¶ 2. This requirement is referred to as definiteness and patent claims that fail it are indefinite. The inventor must inform the public of the limits of the patent monopoly, "so that it may be known which features may be safely used or manufactured without a license and which may not." *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).

Indefiniteness is a question of law for the Court, based on the underlying facts which are not disputed in this case. *See Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001). In this case, the '356 patent claims are insolubly ambiguous and not susceptible to any reasonable construction, and are, therefore, invalid. 35 U.S.C. § 112. For example:

- The asserted claims use words of degree, i.e., "*substantially monolithic*" and "*sufficiently close*," without providing in the '356 patent specification a workable, objective standard for determining what degrees of "monolithicness" and closeness are covered by the claims. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1351 (Fed. Cir. 2005) ("When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree."). There is no genuine issue of material fact since both experts agree on this point. (ATC's Statement of Undisputed Material Facts In Support of Its Motion For Summary Judgment of Indefiniteness ("Undisputed Facts") ¶¶ 6-11,

[1] The '356 patent is attached hereto as Exhibit 1.
[2] *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004).

14-19.)

- The claim term requiring contacts "located sufficiently close … to form a first fringe-effect capacitance" is also alleged to be the novel aspect of claim 1, yet it does not distinguish the invention from specific prior art discussed in the '356 patent specification and it is an improper functional, as opposed to a structural, limitation. (Undisputed Facts ¶¶ 20-24.) *See Gen. Elec. Co.*, 304 U.S. at 371 ("the vice of a functional claim exists … when the inventor … uses conveniently functional language at the exact point of novelty."); *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1252 (Fed. Cir. 2008) (the evaluation of a claim's indefiniteness properly includes "whether the patent expressly or at least clearly differentiates itself from specific prior art [discussed in the patent specification]").

Accordingly, ATC is entitled to summary judgment that all of the asserted claims are invalid for indefiniteness.

II. ARGUMENT

A. Legal Principles

1. Summary Judgment

Summary judgment is equally appropriate in a patent case as it is in any other type of case. *Spectra Corp. v. Lutz*, 839 F.2d 1579, 1581 n.6 (Fed. Cir. 1988). Summary judgment "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." FED. R. CIV. P. 56(c). ATC, as the movant, bears the initial burden of showing the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986).

Once the moving party makes this showing, the burden shifts to the non-moving party to go beyond the pleadings and "designate specific facts showing that there is a genuine issue for trial." *Id.* at 324.[3] The court must scrutinize the evidence proffered by the non-moving party to determine

[3] All emphasis in the quotations has been added and citations and quotations have been omitted in this brief unless otherwise noted.

if it raises a genuine issue of material fact. "If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249-50 (1986). For example, conflicting opinions of experts may not create a genuine issue, particularly where an expert's opinions are conclusory and lacking in foundation. *See, e.g., Novartis Corp. v. Ben Venue Labs., Inc.*, 271 F.3d 1043, 1051 (Fed. Cir. 2001).

2. Definiteness Of Patent Claims

A claim is indefinite when "a skilled artisan could not discern the boundaries of the claim based on the claim language, the specification, and the prosecution history, as well as her knowledge of the relevant art area." *Halliburton*, 514 F.3d at 1249-50.[4] Put another way, a "claim is indefinite if its legal scope is not clear enough that a person of ordinary skill in the art could determine whether a particular [apparatus] infringes or not." *Geneva Pharmaceuticals, Inc. v. Glaxosmithkline PLC,* 349 F.3d 1373, 1384 (Fed. Cir. 2003).

B. Claim 1 Is Indefinite

1. Claim 1 Is Invalid Because It Contains Three Indefinite Claim Elements

Claim 1 of the '356 patent recites:[5]

1. A capacitor comprising:

a substantially monolithic **[1]** ***dielectric body***;

a conductive first plate disposed within the dielectric body;

a conductive second plate disposed within the dielectric body and forming a capacitor with the first plate;

a conductive first contact disposed externally on the dielectric body and electrically connected to the first plate; and

a conductive second contact disposed externally on the dielectric body and electrically connected to the second plate, and ***the second contact being located***

[4] Indefiniteness has to be shown by clear and convincing evidence. *Halliburton*, 514 F.3d at 1249.
[5] Indefinite elements are shown in bold with particular emphasis on three terms numbered in brackets [] and underlined.

***sufficiently close* [2] *to the first contact to form a first fringe-effect capacitance* [3] *with the first contact*.** (Ex. 1, col. 12, l. 59 – col. 13, l. 5.)

a. The Term "A Substantially Monolithic Dielectric Body" In Claim 1 Is Indefinite Because There Is No Workable, Objective Standard For Measuring This Purported Degree Of "Monolithicness"

Claim 1 is indefinite because it uses words of degree–"substantially monolithic"–but the specification fails to provide a workable, objective standard for determining what purported degree of "monolithicness" is covered by the claim and how to measure it. *Datamize,* 417 F.3d at 1351 ("When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree.").[6]

Presidio admits and there is no factual dispute that the '356 patent specification "does not expressly define the phrase *substantially monolithic* dielectric body …." (Pres. Markman Br. at 8.) (Undisputed Facts ¶ 6.) Presidio's Dr. Godshalk also admits there is no test in the technical literature or elsewhere to determine whether a dielectric body is *substantially monolithic*. (Tr. at 253:10-18.)[7] (Undisputed Facts ¶ 7.)

The plain language of claim 1 presupposes the existence of dielectric bodies with varying degrees of "monolithicness," including dielectric bodies that are monolithic, substantially monolithic (as claimed), insubstantially monolithic, and non-monolithic. Such degrees or categories are nothing new in the patent law. In a recent case, the Federal Circuit held that the term "partially hidden from view" essentially created at least two mutually exclusive categories: partially hidden and totally hidden. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, Appeal No. 2008-1027, slip op. at 6, 7 (Fed. Cir. June 4, 2008) (holding that "partially hidden from view" does not encompass objects "totally hidden from view").[8]

---

[6] The mere presence of words of degree, i.e., "a *substantially monolithic* dielectric body," in claim 1 does not *ipso facto* render the claim indefinite. *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984) (claim term requiring "a height *substantially equal* to … the thickness" definite since the patent specification "clearly set[] forth" its meaning in terms of the relationship between height and thickness); *Allergan Sales Inc. v. Pharmacia & Upjohn Inc.*, 42 U.S.P.Q.2d 1560, 1563 (S.D. Cal 1997) (claim term a "*relatively small* incision" in ocular tissue definite since the patent specification disclosed that it was a "smaller incision[] made in the ocular tissue than would be possible with any rigid intraocular lens of a comparable size.").

[7] "Tr." refers to Dr. Godshalk's deposition transcript, which is attached hereto as Exhibit 2.

There can be no genuine dispute that a dielectric body is either monolithic or it is not; "monolithic" is an absolute term. ATC's expert Dr. Dougherty unequivocally opined that "there are no degrees of monolithicness."[9] (Dougherty ¶ 27.)[10] (Undisputed Facts ¶ 10.) Consequently, the '356 patent leaves a skilled artisan to guess as to whether a particular dielectric body is, or is not, "substantially monolithic" in accordance with claim 1. (Dougherty ¶ 35.) This inability of a skilled artisan to discern the limits of the monopoly asserted by the '356 patent is the epitome of indefiniteness. *Gen. Elec. Co.,* 304 U.S. at 369.

It cannot be disputed that the '356 patent specification only mentions "a substantially monolithic dielectric body" twice, and does not explain how this differs from monolithic, non-monolithic, or insubstantially monolithic dielectric bodies:

> The capacitor of the present invention is an integrated array of capacitors connected in series and/or parallel circuits in a **substantially monolithic dielectric body**.
>
> * * *
>
> In the disclosed embodiments, the capacitor has a **substantially monolithic dielectric body** formed from a plurality of ceramic tape layers laminated together in a green ceramic state and fired to form a sintered or fused monolithic ceramic structure. (Ex. 1, col. 4, ll. 29-31; col. 4, ll. 61-65.)[11] (Undisputed Facts ¶ 8.)

---

[8] Since "partially is not defined in the specification" and the phrase "partially hidden from view" did not appear in the written description, the *Helmsderfer* Court refused to override the ordinary meaning of "partially" and did not equate "partially hidden from view" with "generally hidden from view" or "at least partially hidden from view." *Helmsderfer,* slip op. at 4, 5, 7. (The slip opinion in *Helmsderfer v. Bobrick Washroom Equip., Inc.*, Appeal No. 2008-1027, is attached hereto as Exhibit 3.)

[9] At the Markman Hearing held May 8, 2008, ATC submitted, and the Court accepted, Dr. Dougherty as an expert in the relevant art of the '356 patent. (Markman Tr. at 49.) Presidio admitted with respect to Dr. Dougherty that it that it does "not challeng[e] the credentials of this expert." *Id.* The transcript of the Markman Hearing is attached hereto as Exhibit 4.

[10] "Dougherty" refers to the Rule 4.2 Statement of Dr. Joseph P. Dougherty, which was filed as Exhibit 4 to the Joint Claim Construction Chart, Worksheet and Hearing Statement (Doc. No. 29) and Exhibit 3 to ATC's Opening Claim Construction Brief (Doc. No. 51). It is attached hereto as Exhibit 5.

[11] The file history of the '356 patent also does not define the meaning of this claim term. Notably, Presidio's U.S. Patent No. 6,587,327, which is the parent patent of the '356 patent, never even mentions the concept of "a substantially monolithic dielectric body." (Undisputed Facts ¶ 9.)

These references in the '356 patent specification do not specify what characteristics of the dielectric body must be considered nor do they tell one of ordinary skill in the art what values of those characteristics would satisfy the "substantially monolithic" requirement of claim 1. There is no dispute that the specification lacks a workable, objective standard for determining what degree of "monolithicness" a dielectric body should have to be regarded as within the scope of claim 1.

In *Datamize*, the Federal Circuit affirmed summary judgment of indefiniteness of patent claims requiring a computer display screen to be "aesthetically pleasing." The claims implied the existence of at least two types of displays, *i.e.*, those having "good" aesthetics and those having "bad" aesthetics, yet the patent failed to provide an objective test for determining whether a given display was good or bad. *Datamize,* 417 F.3d at 1352, 1356. The *Datamize* Court noted that the patent specification left unanswered many critical questions such as "which color combinations would be aesthetically pleasing and which would not? And more generally, how does one determine whether a color combination is aesthetically pleasing?" *Id.* at 1352.[12]

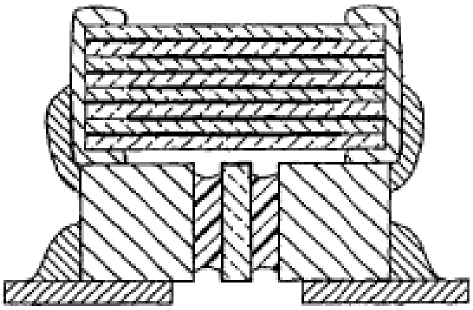
b. Dr. Godshalk Could Not Apply The "Substantially Monolithic" Element To The Capacitors Disclosed In The '356 Patent

Summary judgment that the recitation "a substantially monolithic dielectric body" in claim 1 is insolubly ambiguous, rendering claim 1 invalid for indefiniteness, is appropriate because plaintiff's own expert, Dr. Godshalk, confirmed the absence of any dispute of material facts by his inability to apply this claim term. Dr. Godshalk testified that the capacitor shown in Figure 8A, which is admitted prior art, would not be covered by claim 1 because it is "non substantially monolithic." (Tr. 247:10-12.) When asked whether two capacitors of the type shown in the upper portion of Figure 8A, when stacked atop each other as shown directly below, [13] would be "substantially monolithic" within the meaning of claim 1, Dr. Godshalk could not make such a determination because "[t]hat's so subjective. I can't answer that one." (Tr. 248:22-23, 248:1-8). (Undisputed Facts ¶ 11.)

---

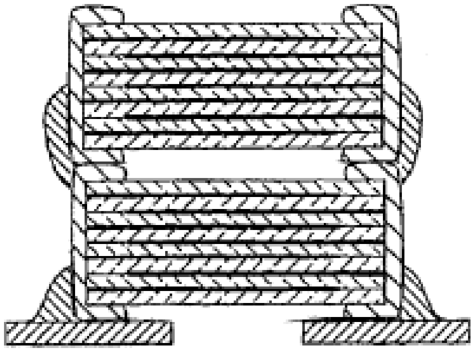
[12] *See also Halliburton*, 514 F.3d at 1253 (claim term "fragile gel" held indefinite since patent specification "fail[ed] to identify the degree of the fragility of its invention").

[13] Modified Figure 8A is presented below as it was verbally described to Dr. Godshalk at his deposition. (Tr. 248:1-23.)



PRIOR ART
FIG. 8A

Not Substantially Monolithic



"That's so subjective. I can't answer that one."

In essence, Dr. Godshalk reached the same conclusion as the Federal Circuit in *Datamize*, which held that absent a "workable objective standard" in the specification or within the general knowledge of a skilled artisan, a claim element that includes words of degree (*viz*., "substantially monolithic") "is completely dependent on a person's subjective opinion" and therefore indefinite. *Datamize*, 417 F.3d at 1350; *see also Geneva Pharmaceuticals,* 349 F.3d at 1384 (a claim term is indefinite if a skilled artisan cannot determine whether a particular apparatus is, or is not, covered by its scope).

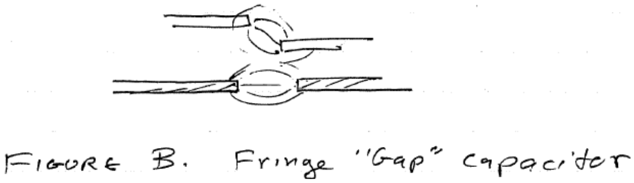
Presidio's argument that the addition of external contacts to a monolithic dielectric body makes that body "substantially monolithic" is without merit and does not create an issue of fact. (Pres. Markman Br. at 8.) The claim language itself shows that the conductive first and second contacts are **separate** elements in claim 1. They are added to an already formed "substantially monolithic dielectric body," which is the first (and separate) element of claim 1. (Ex. 1, col. 12, l. 65 - col. 13, l. 3.) The addition of external contacts does not change the internal structure of the dielectric body, whether it was monolithic, substantially monolithic, insubstantially monolithic, or non-monolithic. There is no need to refer to anything outside of the "dielectric body" to evaluate the body's "monolithicness."[14] Moreover, as external contacts are present in both figures 8A and modified 8A above, this limitation is meaningless, failing to distinctly classify the two capacitors as being within or without the meaning of claim 1.

Accordingly, there is no factual dispute that a skilled artisan cannot determine what is covered by "a substantially monolithic dielectric body," and what is not. As a result, the record lacks an objective, workable standard for determining what purported degree of "monolithicness" is covered by the claim. The Court should therefore hold claim 1 invalid for indefiniteness as a matter of law.

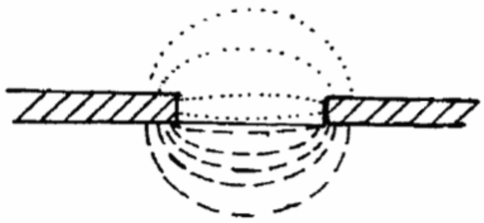
2. The Term "The Second Contact Being Located Sufficiently Close To The First Contact To Form A First Fringe-Effect Capacitance With The First Contact" Is Indefinite

a. There Is No Workable, Objective Standard For Determining What Degree Of Closeness Is Sufficient

There is no dispute that fringe-effect capacitance is always present wherever two electrical conductors are positioned in an edge-to-edge relationship, as depicted below:[15]



Godshalk Tr. Ex. 6



Dougherty ¶ 15

Indeed, Presidio's own Dr. Godshalk admits that this must be true "according to the laws of

[14] Trying to shift attention from the dielectric body onto the capacitor as a whole, Presidio argues that "[t]he capacitor is a substantially monolithic dielectric body." (Pres. Markman Br. at 8.) Even equating the dielectric body, a major part of a capacitor but nonetheless not the whole capacitor, with the capacitor itself and thus applying the "substantially monolithic" requirement to the capacitor, does not cure the indefiniteness. There is no dispute that monolithic capacitors do not have varying degrees of monolithicness. A capacitor is either monolithic or it is not; there is no in between. *See e.g.*, *McGraw-Hill Dictionary of Scientific and Technical Terms* 1294 (Sybil P. Parker, 5th ed. 1993) ("monolithic ceramic capacitor … A capacitor that consists of thin dielectric layers interleaved with staggered metal-film electrodes … compressed and sintered to form a solid monolithic block."). (Dougherty Ex. G.) (*See* Dougherty ¶¶ 27-31.)

[15] Tr. 100:17-21, Ex. 6; Dougherty ¶ 15.

physics." (Tr. 107:11-17.) (Undisputed Facts ¶ 14.) Generally, the closer the edges of the conductors, the bigger the resulting fringe-effect capacitance. (Undisputed Facts ¶ 17.) There is no "magical" distance at which the fringe-effect capacitance suddenly appears.

Against this backdrop, what is required by claim 1 is entirely ambiguous when it recites first and second conductive contacts located "sufficiently close" to form a fringe-effect capacitance, which, according to the law of physics, is already there. Not only does claim 1 lack any recitation of a distance value, but it also employs words of degree (i.e., *sufficiently close*) which are not supported in the patent specification with a workable, objective standard to determine what is "sufficiently close" or, in the alternative, how large or small a fringe-effect capacitance should be. *See Datamize,* 417 F.3d at 1351.

The parties agree that the claim limitation requiring the "first contact" and the "second contact" to be "*located sufficiently close*" is an attempt to define a spatial constraint. In its Markman Brief, Presidio admits that the "claim language describes a *spatial relationship* of two structural components of the inventive capacitor and the resulting capacitance characteristic thereof [i.e., fringe-effect capacitance]." (Pres. Markman Br. at 12.) (Undisputed Facts ¶ 15.) The '356 patent specification, refers to this spatial constraint as the "gap" width between the ends of the contacts 12 and 13:

> **the gap** between … [the ends] 97 and 98, 108 and 109, 117 and 118 [of contacts 12, 13 in Figures 18A and 19A]… **and the fringe capacitances created thereby**. (Ex. 1, col. 12, ll. 18-20.)[16] (Undisputed Facts ¶ 16.)

Not only is claim 1 devoid of the gap width, the '356 patent specification fails to provide even a single numerical value of the gap width between contacts 12 and 13, or even a single value of the fringe-effect capacitance between contacts 12 and 13, for any of the capacitors of the '356 patent. (Undisputed Facts ¶¶ 18, 19.) Dr. Godshalk confirmed that there is "not enough data in this

[16] Similarly, Dr. Godshalk testified that fringe-effect capacitance is called "gap" capacitance. (Tr. 99:6-11, 99:23 - 100:2, Ex. 6.)

drawing, there's no dimensions on the gaps …." (Tr. 231:11-12; 226:11-12; 212:1-5; 114:10-19; 110:14-16; 126:14-15.)

Plainly, it was the patentee's obligations to provide such critical data to define the invention. *See Gen. Elec. Co.*, 304 U.S. at 369 ("claimed inventions, improvements, and discoveries, turning on points so refined … require precise descriptions of the new characteristic for which protection is sought.").[17] It is not a requirement that one skilled in the art unduly experiment or guess. The total lack of a workable, objective standard in the '356 patent specification for determining what degrees of "closeness" is considered to be within the scope of claim 1 and which degrees of "closeness" are without the scope of claim 1 renders claim 1 indefinite. *See Datamize,* 417 F.3d at 1350. Summary judgment of indefiniteness is proper.

b. "Sufficiently Close" Does Not Distinguish The Alleged Invention From Admitted Prior Art

Claim 1 is also indefinite since it does not distinguish the alleged invention from specific prior art identified in the '356 patent specification, including the capacitor of Figure 2A.[18] The Federal Circuit has recently held that the indefiniteness analysis should consider

> whether the patent expressly or at least clearly differentiates itself from specific prior art [identified in the patent specification]. Such differentiation is an important consideration in the definiteness inquiry because in attempting to define a claim term, a person of ordinary skill is likely to conclude that the definition does not encompass that which is expressly distinguished as prior art. *Halliburton,* 514 F.3d at 1252.

The patent in *Halliburton* purported to distinguish the allegedly inventive oil field drilling fluids, called "fragile gels" in the claims, from the admitted prior art fluids shown in a patent figure. *Id.* Since a closer examination of that figure revealed that even the prior art fluids were within the

[17] *See also Poweroasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) ("While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. …[It is] not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure. … Rather it is a question whether the application necessarily discloses that particular device.") (emphasis in the original).

[18] The patentees admitted that Figure 2A illustrates a "known multilayer monolithic capacitor structure" and labeled it "PRIOR ART." (Ex. 1, col. 5, ll. 16-17.) (Undisputed Facts ¶ 24.)

scope of the claimed, inventive "fragile gels," the Federal Circuit held that patentee's "failure to distinguish … the invention from the close prior art … is fatal" to the validity of the claim, rendering it indefinite. *Id.* at 1253. The *Halliburton* Court reasoned that "[w]hile patentees are allowed to claim their inventions broadly, they must do so in a way that distinctly identifies the boundaries of their claims." *Id.*[19]

The '356 patent does not distinguish the alleged invention shown in Figures 18A and 19A from "Prior Art" Figure 2A, since it does not provide values of the gap widths or the fringe-effect capacitances for either of the figures as shown below:[20]

Sufficiently Close | **Not Sufficiently Close**

Gap width = ?
Fringe-effect capacitance = ?

Gap width = ?
Fringe-effect capacitance = ?

Gap width = ?
Fringe-effect capacitance = ?

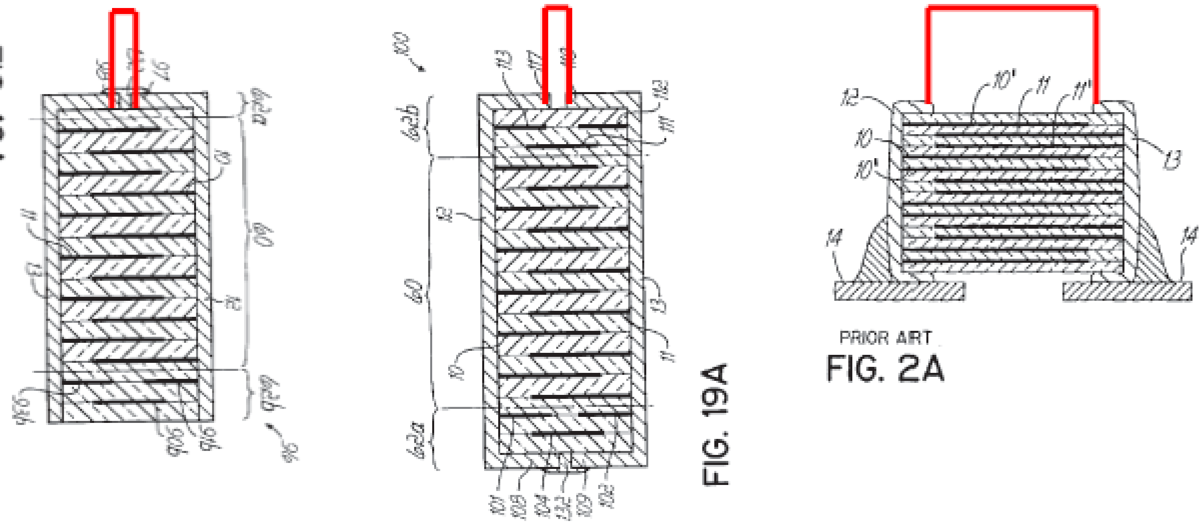


FIG. 18A

FIG. 19A

PRIOR ART
FIG. 2A

Patent drawings are not made to scale.

The '356 patent merely pays lip service to the statutory requirement of definiteness by stating that the contacts 12 and 13 in Figures 18A and 19A are "sufficiently close," whereas in Figure 2A they are not.[21] At his deposition, Dr. Godshalk admitted that according to the laws of

[19] *See also Amgen, Inc. v. Chugai Pharma. Co.,* 927 F.2d 200 (Fed. Cir. 1991) (holding claims indefinite since their meaning was in doubt and the prior art was close).

[20] Undisputed Facts ¶¶ 21, 22, 24.

[21] Ex. 1, 10:66-11:3 and 11:31-35. (Undisputed Facts ¶¶ 21, 22.)

physics a fringe-effect capacitance must exist between contacts 12 and 13 in the prior art capacitor of Figure 2A: "Yeah, under the laws of physics, there's something there." (Tr. 107:11-18, 100:17-21.)[22] (Undisputed Facts ¶¶ 14, 23.) Dr. Godshalk also could not identify the purported distance at which the contacts 12 and 13 would allegedly be "too far" apart to be covered by the claim. (Tr. 114:13-115:5.) In essence, Drs. Godshalk and Dougherty agree that "sufficiently close" contacts does not set a distinct boundary between claim 1 and specific, admitted prior art. (Dougherty ¶¶ 56-57.)[23]

c. "Sufficiently Close" Is Improper Functional Claiming At The Point of Novelty

There can be no genuine dispute that the alleged point of novelty in claim 1 of the '356 patent resides in this "sufficiently close" claim element. Indeed, Dr. Godshalk stated that this claim element defines the "central idea" and "novel aspect" of the invention. (Tr. 124:9-11; 138:4-8; 139:11-140:2; 144:14-19; 145:3-16.) (Undisputed Facts ¶ 20.) Particular scrutiny is required where, as here, the patentee used "functional language" at the alleged point of novelty, by claiming the alleged invention by what it is intended to do, i.e., form a fringe-effect capacitance by locating contacts sufficiently close, rather than what it is, i.e., structural dimensions of the contacts. In *General Electric*, the Supreme Court instructed that "the vice of a functional claim exists … when

[22] Presidio's counsel also admitted at the Markman Hearing held May 8, 2008 that "fringe-effect capacitance is … a known commodity. We understand that …." (Markman Tr. at 104.)

[23] Attempting to distinguish the alleged invention from the admitted prior art, Presidio tries to rewrite claim 1 to require that the fringe effect "affects high frequency performance of the capacitor as a whole." (Pres. Markman Br. at 11-12.) This is improper and is itself indefinite for the reasons set forth in ATC's Opening Claim Construction Brief at 20-23 (Doc. No. 51) and ATC's Reply Claim Construction Brief at 5-9 (Doc. No. 54).

Even according to Presidio's construction, what constitutes "high frequency" and the degree of improved effect on "high frequency performance" are still ambiguous. *See Halliburton*, 514 F.3d at 1253 ("By failing to identify the degree of the fragility of its invention, Halliburton's proposed definition would allow the claims to cover not only that which it invented that was superior to the prior art, but also all future improvements to the gel's fragility. … [F]luids of the … invention may … break more quickly … than the prior art fluids, but the degree of improved speed remains ambiguous.").

the inventor is painstaking when he recites what has already been seen [in prior art], and then uses conveniently functional language at the exact point of novelty."[24]

This is not to say that functional claiming is indefinite *per se*. To use it properly, the patentee needed to disclose in the specification a quantitative metric or a formula for calculating fringe-effect capacitance together with numerical, structural dimensions that met the functional limitation as well as dimensions that did not. *See Halliburton,* 514 F.3d at 1255-56, n. 6 (rejecting as indefinite a functional claim term "ability to transition quickly from gel to liquid" since patent specification lacked data indicating how quickly the gel must break.) Again, by Dr. Godshalk's own admission, the '356 patent does not provide this critical information. (Tr. 231:11-12; 226:11-12; 212:1-5; 114:10-19; 110:14-16; 126:14-15) Dr. Dougherty agrees. (Dougherty ¶¶ 56-57.) (Undisputed Facts ¶¶ 18-24.) Thus, there is no genuine fact dispute that claim 1 does not distinguish the alleged invention, which is defined only functionally in the claims, from admitted prior art. The Court should grant summary judgment of invalidity for indefiniteness.

d. Gap Width Alone Does Not Make Claim 1 Definite

Even disclosure of a value for gap width would not make claim 1 definite because gap width is only one of several variables that directly affect fringe-effect capacitance and one of them does not predefine the others. Capacitors that have the same gap width can have widely varying fringe-effect capacitances depending upon the thickness (T), lengths (L), and widths (W) of the contacts 12 and 13 and the dielectric constant (ε_r) of the dielectric material.[25]

Gap width (g) is typically measured in mils, which stands for 1/1000th of an inch. For example, assuming a gap width of approximately 44 mils, a typical capacitor of 0.06 by 0.03 inches, referred to as "0603" capacitor, provides a fringe-effect capacitance between the contacts of about

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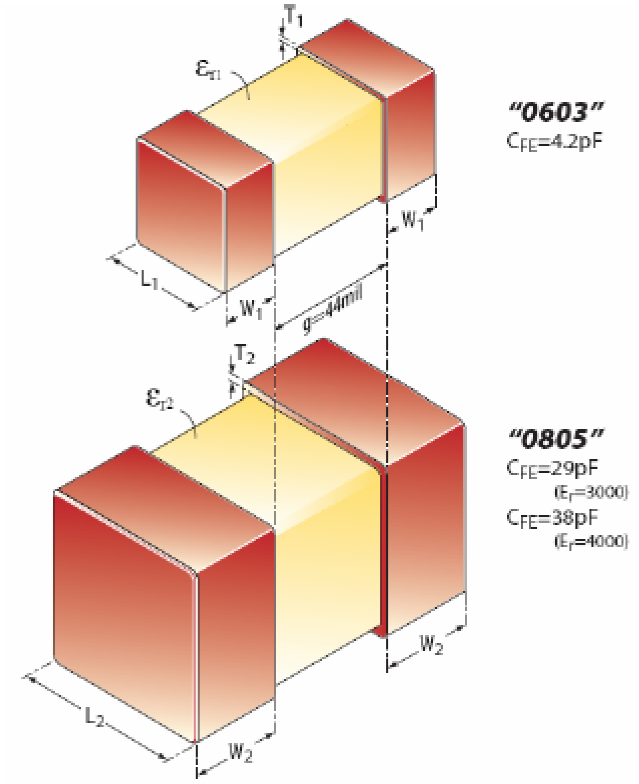
[24] *Gen. Elec. Co.*, 304 U.S. at 371 (holding patent claims invalid where the grains of the claimed lighting filament were distinguished from the prior art only because they were "of such size and contour as to prevent substantial sagging and offsetting" of the filament).

[25] These and other variables are part of an accepted formula for approximating fringe-effect capacitance. (Dougherty n. 4; Dougherty Ex. F) (Undisputed Facts ¶¶ 25, 26, 28.)

4.2 pF. (Dougherty ¶ 15.) Holding the gap width constant at approximately 44 mils and considering another typical size capacitor called "0805" (i.e., 0.08 by 0.05 inches), the fringe-effect capacitance between the contacts of 0805 capacitor is 38 pF or 29 pF depending on the dielectric material.[26] The fringe-effect capacitance of 38 pF is almost an order of magnitude greater than the fringe effect of 4.2pF of the 0603 capacitor with the same gap width.[27] Thus, there can be no fact dispute that gap width alone does not define what is "sufficiently close … to form a first fringe-effect capacitance." This undisputed fact is illustrated below:



[26] This calculation is presented for length L equal to approximately 50 mil (1.27 x 10^{-3} m); width W equal to approximately 18 mil (4.57 x 10^{-4} m); and thickness T equal to approximately 8 mil (2 x 10^{-4} m). The dielectric constant ε_r, also referred to as the relative permittivity, of a typical barium titanate-based dielectric is 3000 or 4000.

[27] The sole mention of 2 mils as a separation between the ends of pads 122 and 124 does not cure the indefiniteness. First, that distance is not relevant to claim 1 as pads are not contacts 12 and 13. Second, more than just the gap width between the contacts determines the fringe-effect capacitance. Dr. Godshalk testified that even a 30 mil spacing can give rise to fringe-effect capacitance. (Tr. 114:20 - 115:5.) Certainly, this sole mention of a gap width is not a "workable objective standard" for determining what is being claimed, since merely knowing the gap width would not inform a skilled artisan as to what fringe-effect capacitance would result. *See Datamize*, 417 F.3d at 1350.

The fact that the '356 patent does not even mention these additional factors, much less provide their values for the capacitors shown in the '356 patent,[28] underscores the failure of the '356 patent specification to identify the boundaries of this functional claim element. Thus, a person of ordinary skill in the art cannot determine what is covered by the claim, and what is not. (Dougherty ¶¶ 56, 57.)

There is no fact dispute that his claim term requires the contacts to be "located sufficiently close … to form a first fringe-effect capacitance" and this term is insolubly ambiguous and incapable of construction or practical application.

3. The Term "A First Fringe-Effect Capacitance" Is Indefinite Because The '356 Patent Does Not Define How To Identify Which Fringe-Effect Capacitance In The Capacitor Is The "First"

Every word in a patent claim, in this instance "first" as in "a *first* fringe effect-capacitance," is presumed to have meaning. *Elekta Instrument S.A. v. O.U.R. Sci. Intern., Inc*., 214 F.3d 1302, 1307 (Fed. Cir. 2000). Here, the patentees carefully selected words to call out a specific capacitance–"a *first* fringe-effect capacitance" formed between the conductive contacts. This coupled with the presumption that every word in the patent claims has a meaning requires that the word "first" presupposes some criteria for choosing a particular fringe effect from several fringe-effect capacitances formed between the contacts.

There is no dispute that neither the claim itself, nor the '356 patent specification, discloses such criteria (e.g., is it the fringe-effect capacitance that is closest to or the farthest from the circuit board?). (Undisputed Facts ¶ 29.) Dr. Dougherty, an expert in the field, opined that "the recitation of a first fringe-effect capacitance presupposes the presence of other fringe-effect capacitances, and the claim does not particularly point out and distinctly claim which of these multiple fringe-effect capacitances, if any, is captured by the claims." (Dougherty ¶ 56.) The "first" fringe-effect capacitance cannot be selected at random because this would essentially read the word "first" out of the claim, requiring only "a fringe-effect capacitance" as opposed to "a first fringe-effect

[28] Undisputed Facts ¶ 27.

capacitance." *Elekta*, 214 F.3d at 1307 (giving meaning to every word in a patent claim and rejecting a construction which would render a word superfluous). Thus, the failure of the '356 patent to provide criteria for identifying which fringe-effect capacitance is considered to be the "first" renders claim 1 invalid for indefiniteness as a matter of law.

C. Dependent Claims 2-5, 16, 18 and 19 Are Indefinite Because They Do Not Cure The Deficiencies Of Claim 1

It is a fundamental principle of patent law that "a claim in dependent form … incorporate[s] by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112, ¶ 4. Thus, dependent claims 2-5, 16, 18 and 19 incorporate the indefinite claim elements of claim 1. There can be no factual dispute that the dependent claims do not further limit the indefinite elements noted above and incorporated from claim 1 and thus do not cure their indefiniteness. (Undisputed Facts ¶ 30.) For example, claims 2 and 4 add insulating layers which do not cure the indefiniteness of "substantially monolithic dielectric body" or of contacts being "sufficiently close to form fringe-effect capacitance." Similarly, claims 3, 5, 16, 18 and 19 add other requirements for the dielectric body, such as multiple or parallel sides (claims 3 and 5) and a hexahedron shape (claim 19), or requirements for a ceramic composition (claims 16 and 18). None of these limitations clarify or further define what is "substantially monolithic" or "sufficiently close." *See Datamize,* 417 F.3d at 1356 (affirming summary judgment that both the independent claim and its corresponding dependent claims were indefinite).

These dependent claims are invalid for indefiniteness as a matter of law for the same reasons set forth above in Section II.B.

D. Dependent Claims 3, 18 and 19 Contain Additional Indefinite Claim Terms

1. In Claim 3, The Term "The Second Contact Being Located Sufficiently Close To The First Contact On The Second Side Of The Dielectric Body To Form A Second Fringe-Effect Capacitance With The First Contact" Is Indefinite

This claim term is indefinite for the same reasons set forth for the "sufficiently close" claim element in claim 1 discussed in Section II.B.2. (Undisputed Facts ¶ 31.) Accordingly, the Court should grant summary judgment that this claim term renders claim 3 invalid for indefiniteness as a matter of law.

2. Claim 18: "The Ceramic Body"

Claim 18 includes the following indefinite claim term:

> 18. The capacitor of claim 1 wherein ***the ceramic body*** comprises a plurality of ceramic tape layers laminated together in a green ceramic state and fired to form a cured monolithic ceramic structure.

(Ex. 1, col. 14, ll. 9-12.)

There can be no dispute that the claim term "*the*" ceramic body" lacks antecedent basis since there is no prior recitation of "*a* ceramic body" in claim 18 or claim 1. (Undisputed Facts ¶ 32.) Dr. Godshalk testified that he "did not see" the phrase "ceramic body" in claim 1. (Tr. 267:21-23.) Thus, lacking an anchor or antecedent basis, the term "the ceramic body" does not have a reasonably ascertainable meaning. A skilled artisan cannot discern whether claim 18, which depends from claim 1, is referring to the "dielectric body" of claim 1 while imposing a new requirement for the dielectric to be ceramic, or whether it is introducing a new element, a second "body" which is made from ceramic. (*See* Dougherty ¶ 72.) The disclosure of a two-bodied capacitor in Figures 8A and 8B of the '356 patent,[29] in addition to single-bodied capacitors, underscores this possibility.

In addition, in the former case, the recitation "the ceramic body" would also be ambiguous as to how much of the dielectric is required to be ceramic. For example, must the dielectric be entirely ceramic or can it include ceramic as well as other dielectric materials? Accordingly, this claim term renders claim 18 invalid for indefiniteness as a matter of law. *See Messerschmidt v. United States*, 29 Fed. Cl. 1, 42-43 (Fed. Cl. 1993) (granting summary judgment of indefiniteness based on the lack of antecedent basis for claim elements "said first and second levers" where it could not be determined which of "no less than seven levers" referred to in the specification were being claimed).

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[29] Undisputed Facts ¶ 33.

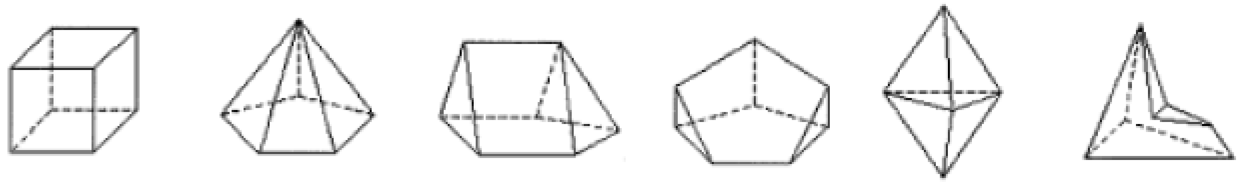
3. Claim 19: "The Dielectric Body Has A Hexahedron Shape"

Claim 19 includes the following indefinite claim term:

> 19. The capacitor of claim 1 wherein ***the dielectric body has a hexahedron shape***, the first and second external conductive contacts being positioned on opposed end surfaces of the hexahedron shape. (Ex. 1, col. 14, ll. 13-16.)

Though purporting to claim a dielectric body having a particular *shape*, claim 19 is indefinite because the term "hexahedron" merely states the requisite number of sides of the dielectric body (i.e., six) without defining any shape whatsoever. (Dougherty ¶ 74.) Defining a shape of a three-dimensional object requires the number of sides plus their respective interrelationships and geometries (e.g., vertices, angles, etc.). For instance, a "cube" indicates the number of sides, i.e., six, and inherently provides information regarding their geometries, including that the sides are equal squares and that adjacent sides of the cube are perpendicular to each other.

In contrast, the term "hexahedron" does not provide any such detail since it only conveys the number of sides (i.e., six) without providing any information regarding geometry. There is no dispute that all of the objects reproduced below are hexahedrons. (Tr. 77:17-20; 80:5-7.) (Undisputed Facts ¶ 35.) Yet they do not share or define a common shape:



(ATC Markman Rep. Br. at 9.) Dr. Godshalk admitted that the term "hexahedron" covers *any* object with six sides and does not define a shape:

> Q. But you would agree that the term hexahedron covers any object with six sides?
> A. Yeah, encompasses much more, I agree.
> Q. And would you agree, also, that the term hexahedron does not define a shape?
> A. Yeah, in its widest definition, I would agree with you.

(Tr. 80:5-11.) (Undisputed Facts ¶¶ 36, 37.) Thus, since hexahedron is shapeless, the claim term "hexahedron shape" means "shapeless shape" which is indefinite. It is, thus, entirely unclear what claim 18 covers when it claims a "hexahedron shape." There can be no dispute that the '356 patent does not cure this problem since Presidio admits that "the specification and prosecution history provide no definition for hexahedron shape." (Pres. Markman Br. at 13.) (Undisputed Facts ¶ 34.)

CONCLUSION

For the reasons set forth above, ATC's motion for summary judgment of indefiniteness of all of the asserted claims 1-5, 16, 18 and 19 of the '356 patent should be granted as a matter of law.

Dated: June 11, 2008

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.

By: /s/ Timur Slonim

Daniel T. Pascucci, Esq.
dpascucci@mintz.com
Nathan R. Hamler, Esq.
nhamler@mintz.com
Marvin S. Gittes, Esq. (*pro hac vice*)
mgittes@mintz.com
Timur E. Slonim, Esq. (*pro hac vice*)
tslonim@mintz.com
Peter F. Snell, Esq. (*pro hac vice*)
psnell@mintz.com
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.
666 Third Avenue
New York, NY 10017
Telephone: (212) 692-6800
Facsimile: (212) 983-3115

CERTIFICATE OF SERVICE

I, the undersigned, certify and declare that I am over the age of 18 years, employed in the County of New York, State of New York, and am not a party to the above-entitled action.

On June 11, 2008, I filed and served a copy of the following document(s):

ATC'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS (with accompanying exhibits)

by electronically filing the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

Miles D. Grant, Esq. Grant & Zeko, APC 1331 India Street San Diego, CA 92101	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: mgrant@grantandzeko.com
Gregory F. Ahrens, Esq. Wood Herron and Evans 441 Vine Street 2700 Carew Tower Cincinnati, OH 45202	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: gahrens@whepatent.com
Brett A. Schatz, Esq. Wood Herron and Evans 441 Vine Street Carew Tower Cincinnati, OH 45202	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: bschatz@whepatent.com

Executed on June 11, 2008, at New York, New York.

/s/ Timur Slonim
Timur Slonim